

## **REMARKS/ARGUMENTS**

### **Related Applications and Supplemental IDS**

Prompted by the pending double patenting rejection, the Applicant wishes to formally notify the Examiner of the following applications which share with the subject application a claim of priority from a common Provisional Application 60/408,860:

<u>App Ser.</u>	<u>Published As</u>	<u>Attney Docket</u>	<u>Examiner</u>
10/601,225	US 2004/004774	P-US-JK-01507	Ex. Frantz / AU3746
10/600,040	US 6,923,364	P-US-JK-01507B	Ex. Stoner / AU1725

The accompanying supplemental IDS contains references identified in those two applications and not yet cited in the subject application, as well as prior art references from other sources.

### **In the Claims:**

#### **Objections Under 37 CFR 1.75(c)**

Claims 66 and 74 are objected to for improper dependent form. Claim 66 is amended to depend from independent claim 51. Claim 74 is amended to depend from independent claim 68.

#### **Double Patenting Rejection**

Claims 68-72 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims of US App Ser. 10/805836 in view of Ushiota '836. The subject application and US App Ser 10/805836 are commonly owned by Black & Decker (U.S.) Inc. Therefore, a terminal disclaimer is filed herewith, in order to overcome the double patenting rejection.

#### **Rejections Under 35 USC §103**

Previously presented claim set 68-74 stand rejected under 35 USC 103(a) as unpatentable over Ushiota '067 in view of Beckman '436.

Independent claims 68 requires that the shroud include an interior surface, and an arrangement of integral internal support members projecting from the interior surface, and the motor, air tank and air compressor are supported within the shroud on the internal support members. For example, independent claim 68 reads:

68. A hand portable air compressor assembly, comprising:  
an air tank for containing air at an elevated pressure;  
an air compressor for supplying air for storage in the air tank;  
a motor for driving the air compressor; and  
a plastic shroud substantially enclosing the air tank, the air compressor, and the motor including, and  
wherein the shroud includes an interior surface, and an arrangement of integral internal support members projecting from the interior surface, and the motor, air tank and air compressor are supported within the shroud on the internal support members. (emphasis added)

As the Examiner has noted (Action Pg 3 last paragraph), Ushiota's shroud does not support the tank, compressor and motor. According to the Examiner, Beckman '436 discloses a plastic shroud with integral internal support members, and that it would have been obvious to construct the generally disclosed shroud of Ushiota as more clearly shown in Beckman. Applicant respectfully traverses the Examiner rejection for the following reasons.

*A: Modifying Ushiota In The Suggested Manner Will Undo A Number Of Ushiota's Claimed Advantages And Is Thus Not Obvious*

In US 5,030,067 to Ushiota, the tank 46, compressor 42, and apparently the motor (not shown) are joined together by joining part 48 into a rigid air compressor assembly 40 including legs 64. Ushiota '067 col. 3 lines 10-15. The Ushiota air compressor assembly 40 is supported on legs 64. Id. at lines 16-26. Various alternative structures for those legs are the focus of the Figs. 9-12 embodiments of Ushiota '067. Id. col. 4 line 62 to col. 7 line 15. The cited embodiment of Ushiota '067 Fig. 8 does provide a shroud, but the tank, compressor, and motor remain supported by the legs 86/88 projecting through the shroud. Indeed, the legs of the Ushiota air compressor assembly are the focus of that invention. All of the claims in Ushiota contain

limitations to legs wherein “the legs are attached to the compressor body” and the “compressor body” is required to be a: a compressor body for supplying compressed air to the air tank, the compressor body being of a generally circular cross section, . . .” which would exclude the shroud as an intermediate piece. See Ushiota Claim 1.

Furthermore, Ushiota stresses a particular structural arrangement wherein the tank 46 and compressor 42 are structurally joined to each other via an arrangement of plane plates 52, 54, projections 56, and bolts 58. See Ushiota ‘067 col. 3 lines 27-50. According to Ushiota this particular structural arrangement is “more compact” (Id. col 4 lines 7-15.) and compactness is a quality repeatedly stressed as an objective and improvement of the Ushiota design. See, e.g. Ushiota “Summary of the Invention” at col. 1 lines 31-61.

Modifying Ushiota as suggested by the Examiner so that the tank and compressor are supported by the shroud, and not by each other, and not directly connected to the specialized Ushiota feet will compromise the compact and vibration isolated design features, which are the key objectives and improvements of the Ushiota invention. Therefore, such a modification would not be obvious.

*B. Beckman ‘436 Does Not Provide The Motive Or Suggestion To Modify Ushiota In The Proposed Manner*

According to the Examiner “it [is] obvious to construct the generically disclosed shroud of Ushiota et al as more clearly shown in Beckman et al in order to provide lightness, durability, and also to support the members within the shroud so the elements to not “rattle around” and translate relative to the shroud when the shroud is lifted and set down. Action Page 4 lines 2-5.

First, the Applicant respectfully notes that none of those reasons given by the Examiner for why it would be obvious to modify Ushiota in view of Beckman are found in Beckman itself. Beckman does not teach that the provision of internal support structure in its shroud provides “lightness, durability, and [structural

rigidity].” Beckman says nothing about those attributes. Rather, Beckman is concerned with:

- a) A clamshell shroud for mounting controls and gauges. Beckman ‘436 Col. 2 lines 40-55 and Fig. 3;
- b) The shroud internal baffling providing for various cooling air flow paths. Beckman ‘436 Col. 2 lines 56-65 and Figs. 4-5;
- c) Certain provisions for an intake tube and/or condensate valve “roll cage”. Beckman ‘436 Col. 3 lines 1-9; and
- d) The provision of a “rim base” integral with the bottom of the compressor tank. Beckman ‘436 col. 3 lines 9-17.

None of those features of Beckman, or the advantages attributed to them by Beckman, provide the motive or suggestion to modify Ushiota so that the tank, motor, and compressor pump of Ushiota are supported within the Ushiota shroud on a number of internal supports projecting inward from that shroud, rather than on a separate internal metal chassis, and as required by the rejected claims.

According to the Examiner, Beckman clearly shows integral internal support members and cites to Beckman Fig.4 and reference numbers 102 and 92. Action Pg.4 lines 1-2. Applicants respectfully note that reference number 92 is described as an “integral mounting location”, but only the manifold 96, gauges 74, 76, regulator knob 78 and air valves 84 and 86 are described or depicted as mounted thereto. Beckman ‘436 col. 5 lines 36-50. Reference number 102 is one of several cylinders that cooperate with mounting pins 100 to guide and align the upper and lower clamshell halves 50, 52. Id. col. 5 lines 50-66. Neither Beckman’s mounting locations 92 nor pins and cylinders 100, 102 are described as supporting the tank (which is wholly outside the Beckman shroud), the motor 26, or the pump 24.

Rather, Beckman’s shroud 22, pump 24, and motor 26 are described as mounted to on platform 38 attached to the top of the compressor tank 28. Beckman ‘436 col. 4 lines 55-57 and Fig. 2. Beckman’s tank 28 is completely outside of the shroud 22. Id. Fig. 1. Furthermore, within the shroud 22, pump 24 and motor 26 are described as

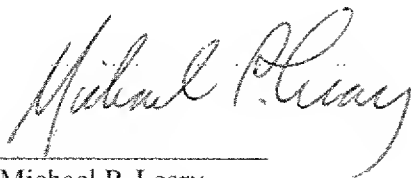
mounted to "common mounting frame 120". Id. col. 6 lines 1-6. Moreover, frame 120 is not described as a part of shroud 22, but rather "mounting frame 120 . . . extends through the middle of the bottom 52 [of the shroud]". Id. Thus, mounting frame 120 appears to be an element/extension of platform 38 that projects into the shroud 22 and the motor/pump subassembly are mounted to the platform 38, in the conventional manner, and not to any internal support structure of shroud 22.

Therefore, since none of the three claimed components (tank, motor, or compressor) are apparently supported within Beckman my means of the claimed "arrangement of integral internal support members projecting from the interior surface" of the shroud, it can not be said that Beckman '436 provides teaching, motive or suggestion to modify Ushiota '067 in the manner proposed by the Examiner.

Allowable Subject Matter / New Claim

The Examiner has indicated that claim 73 would be allowable if rewritten in independent form. Therefore new claim 76 is submitted. It contains all the limitations of claim 73, base claim 68 and intervening claims 69 and 70.

Respectfully submitted



Michael P. Leary  
Registration No. 41,144  
Attorney for Applicant(s)  
July 22, 2008

Michael Leary - TW199  
The Black & Decker Corporation  
701 East Joppa Road  
Towson, Maryland 21286  
Telephone: (410) 716-2773